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REMARKS

Upon entry of the amendments herein, claims 2-9, 11-17, 19-23, 25, 26, 28-33, 41, 42, 47, 54, 61 and 64 are pending in the application. Claims 2, 4, 8, 9, 15, 16, 23, 25, 32, 33, 41, 42, 47, 54 and 61 have been amended; and new claim 64 has been added. Of the pending claims, 2, 4-8, 31, 41, and 42 are currently under consideration by the Examiner and the remainder, except 64, stand withdrawn and awaiting possible reinstatement. Claim 64 is newly added and, as a method claim, should be added to other claims of this class at the time of their reinstatement. In any event, no new matter has been introduced by any of the amendments herein.

In response to Applicants' request regarding rejoining of the kit and method claims, the Examiner has suggested that said claims be amended to delete their dependence from claim 3, indicating that this would "facilitate continued prosecution of the application." Accordingly, Applicants have herein amended claims 4, 8, 9, 16, 25, 33, 41 and 42 by deletion of this dependence.

The claims currently under consideration have been rejected under 35 U.S.C. §112, second paragraph as being indefinite. In the first place, claims 4-8, 31, 41 and 42 have been rejected for their dependence on nonelected claim 3. Again, as discussed above, this dependence has been deleted from the claims.

Claim 2 has been rejected as indefinite for reciting "a thrombin inhibitor or a derivative thereof"; the Examiner questions what the limits of "derivative" are meant to be. Claim 2 has been amended herein to more particularly recite what is meant by a derivative of a thrombin inhibitor. Support for this amendment can be found in the specification on page 28,

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lines 6-9. Pending claims 9, 16 and 25 have also been amended in this way, and new claim 64 is also reflective of this recitation.

Claims 8 and 42 have been rejected on the allegation that the presence of the word "about" renders the claims indefinite as to the limits of the recited ranges. The word has been deleted by amendment herein from the rejected claims, as well as from pending claims 15, 23, 32, 47, 54, and 61.

Claim 31 has been rejected as indefinite as to the scope of the diseases to be treated; this rejection was discussed with the Examiner on March 1<sup>st</sup>. In the first place, as the Examiner agreed, this rejection should have been applied to claim 25. Secondly, claim 25 (and claim 31, for that matter), is a method claim and was withdrawn from consideration by the Examiner in the wake of the previously leveled restriction requirement.

The Examiner indicated that the rejection of a method claim, Applicants' election notwithstanding, was meant to be a warning to Applicants that upon resolution of the outstanding issues and rejoining of, among others, the method claims, such claims would be subject to an indefiniteness rejection with regard to the diseases to be treated. In order to eliminate the possibility of such an issue being raised in the next Office Action, claim 25, and also claim 33, have been amended to more clearly recite the subject matter regarded as the invention. Support for this amendment can be found in the specification on, for example, page 32, lines 24-27. Also, new claim 64 has been added and should be included among the claims to be considered when the originally filed method claims are rejoined. Support for the new claim can be found on page 3, lines 3-6 of the specification.

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In view of Applicants' last response, some of the previous prior art rejections were withdrawn by the Examiner. However, some of the rejections have been maintained.

Claims 4, 5, 8, 41 and 42 remain rejected under 35 USC §103 as obvious over the combination of US 6,126,939 to Eisenbach-Schwartz et al. and US 6,326,386 to Watson et al. or the combination of Eisenbach-Schwartz et al. and US 6,020,510 to Franson et al. The Examiner maintained this rejection solely on the basis that the claims remained dependent on claim 3. Again, deletion of their dependence from claim 3 herein renders moot this rejection.

Claims 2, 4, 5, 8, 41 and 42 remain rejected as obvious over the combination of US 4,177,277 to Ondetti et al. and US 6,326,386 to Watson et al. The Examiner has not found Applicants' arguments persuasive and maintains that even though there is no strict overlap between the Ondetti and instant compounds, the compounds of Ondetti formula (II) are homologous to some of the instant compounds and are therefore obvious variants. For the record, Applicants wish to clarify that, contrary to the Examiner's assertion, they never argued that a given compound cannot have more than one property. In any event, the definition of R<sub>1</sub> in claim 2 has been amended herein by deletion of all "alkyl" substituents; as a result, no question of homology can possibly be raised. The instantly claimed compounds are clearly distinct from the compounds disclosed by the primary Ondetti reference, and the rejection must be withdrawn.

Further along these lines, the Examiner clarifies in the present Office Action that the issue in this prior art analysis is "that of obviousness versus 'unexpected results'." In other

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words, since the Examiner had alleged the obviousness of the claimed subject matter over the cited prior art, the question to the Examiner was whether or not the unexpected results provided in the specification are comprehensive enough to support Applicants' contention of nonobviousness. However, this question and all of the previous written exchanges between the Examiner and Applicants are moot in light of the amending of claim 2 herein. The issues of scope of thrombin inhibitors and scope of diseases for which the unexpected results have relevance are not germane; no case can be made that the pending claims are obvious over the art of record.

Applicants note the Examiner's written acknowledgement that there is no enablement issue in connection with the presently rejected claims. However, the Examiner also indicated during the March 1<sup>st</sup> discussion that while an indefiniteness rejection of one of the method claims had been leveled, 35 USC §112, 1<sup>st</sup> paragraph is the "real issue" in connection with the methods of treatment. The same amendments made to the method claims in response to the Examiner's indefiniteness "warning" also obviate any possible raising of an issue in connection with enablement and/or written description.

In any event, all of the issues raised with respect to the elected claims have been fully addressed herein and said claims are in condition for allowance. Applicants now await the Examiner's rejoining, consideration and allowance of nonelected, but still pending, claims directed to methods of treatment and kits.

FROM W&C LLP 19TH FL.

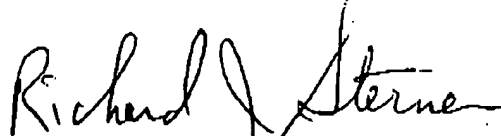
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The Commissioner is hereby authorized to charge any additional fees which may be due in connection with this communication to Deposit Account No. 23-1703.

Dated: April 6, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard J. Sterner", written over a horizontal line.

Richard J. Sterner  
Reg. No. 35,372

Customer No. 007470  
Agent's Direct Line:  
(212) 819-8783